

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Matter of )  
Joseph A. Nguyen, )  
Respondent )  
\_\_\_\_\_ )

Proceeding No. D2019-06

**FINAL ORDER**

Pursuant to 37 C.F.R. § 11.27(b), the Director of the United States Patent and Trademark Office (“USPTO” or “Office”) received for review and approval from the Director of the Office of Enrollment and Discipline (“OED Director”) an Affidavit of Resignation Pursuant to 37 C.F.R. § 11.27 executed by Joseph A. Nguyen (“Respondent”) on February 26, 2019. Respondent submitted the four-page Affidavit of Resignation to the USPTO for the purpose of being excluded on consent pursuant to 37 C.F.R. § 11.27.

For the reasons set forth herein, Respondent’s Affidavit of Resignation shall be approved, and Respondent shall be excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order.

**Jurisdiction**

Respondent of San Jose, California is a registered patent attorney (Registration Number 37,899). Respondent is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq.*

Pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. § 11.27, the USPTO Director has the authority to approve Respondent’s Affidavit of Resignation and to exclude Respondent on consent from the practice of patent, trademark, and other non-patent law before the Office.

**Respondent’s Affidavit of Resignation**

Respondent acknowledged in his February 26, 2019 Affidavit of Resignation that:

1. His consent is freely and voluntarily rendered, and he is not being subjected to coercion or duress.

2. He is aware that, pursuant to 37 C.F.R. § 11.34, the OED Director had filed a Disciplinary Complaint alleging that Respondent violated the USPTO Rules of Professional Conduct, namely: *In re Joseph A. Nguyen*, Proceeding No. D2019-06. The Complaint alleges, *inter alia*, the following:

- a. Respondent represented a client (“Client”) from 2008 to 2017. In connection with Respondent’s representation of Client in a U.S. patent application, Respondent did not file a response to an office action prior to its due date. When Client asked about the status of the application, Respondent told Client that Respondent had pointed out the examiner’s error and was awaiting a response. Respondent had not, in fact, filed a response to the office action, had not requested an extension of time, and that the application had gone abandoned as a result.
- b. Respondent told Client he would file a continuation-in-part (“CIP”) application and Respondent did not do so. The application went abandoned and Respondent did not inform Client about the abandonment.
- c. Respondent filed a Petition to Revive the abandoned patent application allegedly without Client’s knowledge, and when the Office granted the Petition to Revive, Respondent did not communicate that fact to Client.
- d. After the Office revived the application, it issued a Final Rejection of all claims and provided a 3-month period to respond; Respondent allegedly did not communicate with Client about the Final Rejection; Respondent did not respond to the Final Rejection; and that the application went abandoned and Respondent did not communicate with Client about that abandonment.
- e. The Client allegedly instructed Respondent to continue with a certain foreign patent application; Client allegedly understood that the renewal fee for the foreign application would be paid from funds belonging to Client which Respondent was allegedly holding; and Respondent contradicted Client’s instructions in communicating with foreign counsel that Client had decided not to pursue the foreign case further.
- f. Respondent failed to provide complete or timely responses to the Office of Enrollment and Discipline’s Request for Information during its investigation into the conduct set forth above in connection with Respondent’s representation of

Client, and Respondent's failure to provide complete and correct responses and accounting records frustrated OED's investigation.

3. Respondent is aware that based on the allegations set out in the Complaint, the OED Director is of the opinion that he violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.102(a) (It is professional misconduct to fail to abide by a client's decisions concerning the objectives of representation and, as required by §11.104, to fail to consult with the client as to the means by which the client's objectives are to be pursued, and to fail to abide by a client's decision in a matter);
- b. 37 C.F.R. § 11.103 (It is professional misconduct to fail to act with reasonable diligence and promptness in representing a client);
- c. 37 C.F.R. § 11.104(a)(2) (It is professional misconduct to fail to reasonably consult with the client about the means by which the client's objectives are to be accomplished);
- d. 37 C.F.R. § 11.104(a)(3) (It is professional misconduct to fail to keep the client reasonably informed about the status of the matter);
- e. 37 C.F.R. § 11.104(a)(4) (It is professional misconduct to fail to promptly comply with reasonable requests for information from the client);
- f. 37 C.F.R. § 11.104(b) (It is professional misconduct to fail to explain a matter to the extent reasonably necessary to permit the client to make informed decisions);
- g. 37 C.F.R. § 11.115(d) (It is professional misconduct to fail to promptly deliver to the client or a third person any funds or other property that the client or third person is entitled to receive, upon request by the client or third person);
- h. 37 C.F.R. § 11.115(f)(3) (It is professional misconduct to fail to keep readily accessible to the practitioner receipt and disbursement journals containing a record of deposits to and withdrawals from client trust accounts);
- i. 37 C.F.R. § 11.116(a)(2) (It is professional misconduct to fail to withdraw from the representation when the practitioner's physical or mental condition materially impairs the ability of the practitioner to represent the client);
- j. 37 C.F.R. § 11.801(a) (It is professional misconduct to knowingly make false statements of material fact in connection with a disciplinary matter)

- k. 37 C.F.R. § 11.801(b) (It is professional misconduct to fail to cooperate with the Office of Enrollment and Discipline in an investigation of any matter before it, or to knowingly fail to respond to a lawful demand or request for information from an admissions or disciplinary authority);
- l. 37 C.F.R. § 11.804(c) (It is professional misconduct to engage in conduct involving dishonesty, fraud, deceit or misrepresentation); and
- m. 37 C.F.R. § 11.804(d) (It is professional misconduct to engage in conduct that is prejudicial to the administration of justice).

4. Without admitting to the allegations in the Complaint or violating any of the disciplinary rules of the USPTO Rules of Professional Conduct as alleged in the Complaint in *In re Joseph A. Nguyen*, Proceeding No. D2019-06, Respondent acknowledges that, if and when he applies for reinstatement under 37 C.F.R. § 11.60 to practice before the USPTO in patent, trademark, and/or other non-patent matters, the OED Director will conclusively presume, for the purpose of determining the application for reinstatement, that: (a) the allegations regarding him in the Complaint *In re Joseph A. Nguyen*, Proceeding No. D2019-06 are true, and (b) he could not have successfully defended himself against such allegations.

5. Respondent has fully read and understands 37 C.F.R. §§ 11.5(b), 11.27, 11.58, 11.59, and 11.60, and is fully aware of the legal and factual consequences of consenting to being excluded from practice before the Office in patent, trademark, and other non-patent matters; and

6. Respondent consents to being excluded from practice before the USPTO in patent, trademark, and other non-patent matters.

### **Exclusion on Consent**

Based on the foregoing, the USPTO Director has determined that Respondent's Affidavit of Resignation complies with the requirements of 37 C.F.R. § 11.27(a). Accordingly, it is hereby ORDERED that:

1. Respondent's Affidavit of Resignation shall be, and hereby is, approved;
2. Respondent shall be, and hereby is, excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order;
3. The OED Director shall electronically publish the Final Order at the Office of Enrollment and Discipline's electronic FOIA Reading Room, which is publicly accessible at <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
4. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

#### **Notice of Exclusion on Consent**

This notice concerns Joseph A. Nguyen, a registered patent attorney (Registration No. 37,899). The Director of the United States Patent and Trademark Office ("USPTO" or "Office") has accepted Mr. Nguyen's affidavit of resignation and ordered his exclusion on consent from practice before the Office in patent, trademark, and non-patent law.

Mr. Nguyen voluntarily submitted his affidavit at a time when a disciplinary complaint was pending against him. The allegations in the complaint concerned the representation of one client ("Client") from 2008 to 2017. In connection with Mr. Nguyen's representation of Client in a U.S. patent application, Mr. Nguyen did not file a response to an office action prior to its due date. When Client asked about the status of the application, Mr. Nguyen told Client that he had pointed out the examiner's error and was awaiting a response. Mr. Nguyen had not, in fact, filed a response to the office action, had not requested an extension of time, and the application had gone abandoned as a result. Mr. Nguyen told Client he would file a continuation-in-part ("CIP") application and he did not do so. The application went abandoned and Mr. Nguyen did not inform Client about the abandonment. Mr. Nguyen filed a Petition to Revive the abandoned patent application without

Client's knowledge, and when the Office granted the Petition to Revive, Mr. Nguyen did not communicate that fact to Client. After the Office revived the application, it issued a Final Rejection of all claims and provided a 3-month period to respond; Mr. Nguyen did not communicate with Client about the Final Rejection; Mr. Nguyen did not respond to the Final Rejection; and the application went abandoned and Mr. Nguyen did not communicate with Client about that abandonment. The Client instructed Mr. Nguyen to continue with a certain foreign patent application; Client allegedly understood that the renewal fee for the foreign application would be paid from funds belonging to Client which Mr. Nguyen was allegedly holding; and Mr. Nguyen contradicted Client's instructions in communicating to foreign counsel that Client had decided not to pursue the foreign case further. Mr. Nguyen failed to provide complete or timely responses to the Office of Enrollment and Discipline's Request for Information during its investigation into the conduct set forth above in connection with Mr. Nguyen's representation of Client, and Mr. Nguyen's failure to provide complete and correct responses and accounting records frustrated OED's investigation.

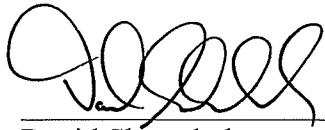
Mr. Nguyen acknowledged that the OED Director was of the opinion that his conduct violated 37 C.F.R. §§ 11.102(a), 11.103, 11.104(a)(2), 11.104(a)(3); 11.104(a)(4); 11.104(b), 11.115(d), 11.115(f)(3), 11.116(a)(2), 11.801(a), 11.801(b), 11.804(c), and 11.804(d).

While Mr. Nguyen did not admit to any of the allegations in the complaint or violating any provisions of the USPTO Rules of Professional Conduct as alleged in the complaint, he acknowledged that, if and when he applies for reinstatement, the OED Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that (i) the allegations set forth in the complaint against him are true, and (ii) he could not have successfully defended himself against those allegations.

This action is taken pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.27 and 11.59. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room, available at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

5. Respondent shall comply fully with 37 C.F.R. § 11.58; and
6. Respondent shall comply fully with 37 C.F.R. § 11.60 upon any request for reinstatement.

(signature page follows)



David Shewchuk  
Deputy General Counsel for General Law  
United States Patent and Trademark Office

14 March 2019  
Date

on delegated authority by

Andrei Iancu  
Deputy Under Secretary of Commerce for Intellectual Property and  
Deputy Director of the United States Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline  
U.S. Patent and Trademark Office

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